



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,840	06/26/2001	Kiyokazu Ikeda	7217/64734	2411

7590 02/09/2005

JAY H. MAIOLI
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036


EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 Office Action Summary	Application No. 09/891,840	Applicant(s) IKEDA, KIYOKAZU	
	Examiner Nicholas D. Rosen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 14-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11, 14-18, 21-23 and 25 is/are allowed.
- 6) ☒ Claim(s) 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-11, 14-23, and 25 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 and 20

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleinberg (U.S. Patent Application Publication 2001/0037265) in view of the article "Online Auto Parts Business Puts Brakes on the Web," hereinafter "Online Auto Parts". As per claim 19, Kleinberg discloses a product cooperative purchase apparatus connected to a network for purchasing both an intangible product and a tangible product from an intangible product sales server and a (perhaps) tangible product sales server, respectively, connected to said network, comprising: communication means for communicating with one of said servers via said network (paragraphs 4, 16, 17, and 18); display means for displaying data supplied from said intangible product sales server (paragraphs 19, 20 and 26; display means being inherent from the display of information to the user); operator means for a user of said product cooperative purchase apparatus to input a request for a desired intangible product, said inputted request being transmitted to said intangible product sales server (paragraphs 19, 20,

38, 39, and 40; the operator means being inherent from the operation of purchasing an insurance policy). Similarly, given what is done in Kleinberg's system, control means for controlling the various means for enabling these things to be done is held to be inherent. Kleinberg does not expressly disclose that the apparatus includes a tangible product sales server (insurance is an intangible product, and the other sales server may be for selling travel planning and reservation services, which can also be viewed as intangible). However, *imprimis*, nothing in the body of claim 19 refers to a tangible product, or the tangible product sales server, and so nothing in the body of the claim breathes life and weight into this phrase from the preamble. *Secundus*, even if "tangible product sales server" is to be regarded as a limitation of claim 19, tangible product sales servers are well known, as taught by "Online Auto Parts," which teaches a website, and therefore a server, for selling brake pads, which are tangible products (especially first two paragraphs of article). The www.discpads.com website of "Online Auto Parts," and the insurance website of Kleinberg would both be on the Internet, and therefore "connected to said network," as claim 19 does not recite any other interaction between the tangible and intangible product sales servers. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for one of the servers to be a tangible product sale server, for the obvious advantage of profiting from the sale of tangible products.

As per claim 20, Kleinberg discloses that said intangible product can be an automobile insurance product (paragraphs 20 and 32). Kleinberg does not disclose that said tangible product is at least one of a car navigating system and a car safety device

to be installed on a vehicle covered by said automobile insurance product, but "Online Auto Parts" discloses a car safety device suitable for installation in an insured vehicle (especially first two paragraphs of article). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the tangible product to be at least one of a car navigating system and a car safety device to be installed on a vehicle covered by the automobile insurance product, for the obvious advantages of profiting from the sale of car navigating systems and/or car safety devices, and advertising automobile insurance products to people interested in buying tangible vehicle-related products, and therefore likely to own automobiles.

Allowable Subject Matter

Claims 1-9 are allowed.

Claim 10 is allowed on essentially the same grounds.

The following is an examiner's statement of reasons for allowance: The closest prior art of record, Kleinberg (U.S. Patent Application Publication 2001/0037265), discloses a sales method in which at least an intangible product sales server for selling an intangible product and a (perhaps) tangible product sales server for selling a (perhaps) tangible product are interconnected by a network for cooperatively selling said intangible product and (perhaps) a tangible product upon request from a user terminal operated by a user, comprising the steps of: searching an intangible product sales server for an intangible product desired by said user based on an operation performed through said user terminal, and displaying a search result on a user terminal

(paragraphs 17-20 and 38-40). Kleinberg does not disclose displaying on said user terminal information about a tangible product associated with said retrieved intangible product, said tangible product being offered for sale by said tangible product sales server, but does disclose doing pretty much this for a second intangible product (insurance) for sale by an intangible product sales server, the second intangible product (insurance) being related to a first intangible product (travel planning and reservation services). Given that tangible product and servers for selling them are well known, this difference from Kleinberg would not be judged sufficient to make claim 1 allowable.

Kleinberg does not disclose discounting a sales price of one of said intangible product and said tangible product when said intangible product and said tangible product displayed on said user terminal are sold simultaneously. Discounts in general are known, but the particulars of discounting the price of one of a tangible and an intangible product when they are sold together do not appear to be taught in the prior art of record. Kozak (U.S. Patent 6,415,226), for example, teaches discounting insurance for drivers who use automobile navigation and safety equipment (column 15), but does not teach or suggest selling the discounted insurance in combination with the navigation and safety equipment, still less doing so in e-commerce. The anonymous article "PNI Teams with Digital Vision" teaches letting users "order CDs at attractive discounts" after downloading "taster" images, but does not teach or suggest that the discounts are conditional on buying the CD's (tangible products) and the images (intangible products) together.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claims 11 and 14-18 are allowed.

Claims 21, 22, and 23 are allowed on essentially the same grounds.

Claims 24 and 25 are allowed on essentially the same grounds.

The following is an examiner's statement of reasons for allowance: The closest prior art of record, Kleinberg (U.S. Patent Application Publication 2001/0037265), discloses a cooperative sales system in which a plurality of servers interconnected via a network cooperatively sell a (perhaps) tangible product and an intangible product associated with each other, having: a user terminal apparatus connected to said network for transferring and receiving data about said sale with said plurality of servers and displaying and inputting said data based on an operation performed by a user of said user terminal apparatus (paragraphs 19, 20, and 26); an intangible product sales server connected to said network for transferring and receiving said data about said sale of said intangible product with said user terminal apparatus and signing a sales contract with said user about said intangible product (paragraphs 25-29, signing a sales contract, etc., being implicit from doing business); and a second product sales server connected to said network for transferring data about said sale of a second product with said user and signing a sales contract with said user about said second product

(paragraphs 19, 20, and 26). Kleinberg does not disclose that the second sales server is a tangible sales server (his second server sells intangible insurance), but it is well known to sell tangible products over the Internet. Kleinberg discloses that the user terminal apparatus comprises terminal communication means (paragraphs 4, 16, 17, and 18), display means (paragraphs 19, 20, and 26), and operator means (paragraphs 19, 20, 38, 39, and 40), the means being inherent from the disclosed actions. Similarly, given what is done in Kleinberg's system, control means for controlling the various means for enabling these things to be done is held to be inherent. Kleinberg discloses that the first intangible product sales server comprises: intangible server communication means for transferring and receiving said data with an other device connected to said network (paragraphs 25-29). Kleinberg is not fully explicit about the first intangible product sales server comprising product data storage means and information storage means for storing intangible product data about the user supplied from the user terminal apparatus, but this is obvious from the activity of the first server in Kleinberg, in that it sells travel planning and reservation services, which implies storing data on what plane tickets, hotel rooms, etc., are available, and who has ordered or reserved what products and services. Kleinberg further discloses that the second product sales server discloses communication means for transferring and receiving said data with an other device connected to said network (paragraphs 25-30 and 32); product data storage for storing product data about the second product, and user information storage means for storing second product data about the user (paragraphs 32, 33, 36, and 38-40). Server

control for enabling the various operations in Kleinberg to be performed is likewise obvious from Kleinberg's disclosure.

Kleinberg discloses that when a purchase order for said second product by a user has been received by the communication means, from the first intangible product sales server, the second server control means executes a second product sales contract based on user information stored by the second server (paragraphs 29, 34, 35, and 40 [payment of sales commissions implies that actual sales take place]).

Kleinberg further discloses transmitting sales transformation about a sales contract of the second product server to the first product server through said network (implied by paying sales commission, as Kleinberg discloses). However, Kleinberg does not disclose changing a sales price of at least one of the intangible and the tangible product upon reception of said sales information from said second sales server. Discounts and other price changes in general are known, but the particulars of changing a price of one of a tangible and an intangible product upon reception of said sales information from said second sales server do not appear to be taught in the prior art of record. Kozak (U.S. Patent 6,415,226), for example, teaches discounting insurance for drivers who use automobile navigation and safety equipment (column 15), but does not teach or suggest selling the discounted insurance in combination with the navigation and safety equipment, still less doing so in e-commerce. The anonymous article "PNI Teams with Digital Vision" teaches letting users "order CDs at attractive discounts" after downloading "taster" images, but does not teach or suggest that the discounts are conditional on buying the CD's (tangible products) and the images (intangible products)

together, or that the price of one product is changed based on reception of sales information from a second sales server.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

Applicant's arguments filed November 5, 2004 have been fully considered but they are not persuasive. The difficulty is that claims 19 and 20 have not been cancelled, although they are described as having been cancelled in the remarks.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER

February 7, 2005